

PROVISIONAL ELECTION

In response to the Restriction Requirement in the August 3, 2006 Office Action, applicant hereby elects Invention I, or in other words, claims 1-11 and 21, **with traverse**. Applicant retains all non-elected claims in the present case subject to appropriate action by the examiner. Should the examiner maintain the restriction requirement, following the comments below, applicant reserves the right to seek rejoinder of the non-elected claims in the future.

REMARKS

I. Status of the Application

Claims 1-21 are pending in the present application. In the August 3, 2006 Office action, the examiner stated that restriction to one of the following groups of claims was required under 35 U.S.C. § 121:

- I. Claims 1-11 and 21, drawn to apparatus a current coil arrangement classified in class 324, subclass 142;
- II. Claims 12-17, drawn to a current coil, classified in class 324, subclass 142; or
- III. Claims 18-20, drawn to a current coil arrangement, classified in class 324, subclass 142.

In this response, applicant has provisionally elected Invention I, consisting of claims 1-11 and 21, **with traverse**. As set forth below, applicant traverses the examiner's restriction of the claims to one of inventions I, II or III.

II. The Restriction Requirement Should be Withdrawn

“Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the others; and (B) the reasons why there would be a serious burden on the examiner if restriction is not required.” MPEP § 808. In the present case, the examiner has provided neither (A) reasons why each invention as claimed is either independent or distinct, nor (B) reasons why there would be a serious burden on the examiner if restriction is required.

A. The Examiner’s Has Failed to Provide Reasons Why the Inventions are Independent or Distinct

“The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.” MPEP § 808.01. “For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed.” Id.

In the August 3, 2006 Office action, the examiner’s sole rationale for establishing that inventions I in a first set and II and III in a second set are related as combination and subcombination was as follows:

“In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination

does not require all of the details of the subcombinations and at least claim 1 serves as an evidence claim that such is the case. The subcombination has separate utility such as by themselves for their intended purposes or in a different combination.” (See August 3, 2006 Office action, page 2).

Nearly identical rationale was provided as support that II and III are related as combination and subcombination.

It is respectfully submitted that the examiner’s has only provided mere statements of conclusion for why each invention as claimed is independent and distinct from the others. In particular, the examiner has merely recited the requirements set forth in MPEP § 806.05(c) for showing that inventions are distinct. The examiner has clearly failed to point out the reasons why he considers the subcombination to have utility by itself or in other combinations, and why he considers that the combination as claimed does not require the particulars of the subcombination as required by MPEP § 808.01. Therefore, the examiner has failed to provide sufficient reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the others, and the examiner’s restriction requirement in the August 3, 2006 Office action should be withdrawn.

B. The Examiner Has Failed to Establish A Serious Burden on the Examiner If Restriction is Not Required

The requirement of the restriction between Inventions I, II and III is improper because it at least fails to meet the requirements of MPEP 808.02 related to the establishment of a “serious burden” on the examiner. According to MPEP 808.02, the examiner must establish that there would be “a serious burden on the examiner if restriction is not required.” Thus, the examiner must show by appropriate explanation

one of the following: (A) separate classification of the inventions; (B) separate status in the art; or (C) a different field of search. MPEP § 808.02.

In the present case, the examiner has not established any reasons why there would be a serious burden on the examiner if restriction is not required. In fact, the examiner can not make the required showing under MPEP § 808.02, as the inventions are not separately classified, the inventions do not have a separate status in the art, and the inventions do not have a different field of search. Accordingly, it is respectfully submitted that the examiner has failed to provide sufficient reasons why there would be a serious burden on the examiner if restriction is required, and therefore, the examiner's restriction requirement is improper and should be withdrawn.

In addition to the above, applicant respectfully notes that this application has been pending for some time and several Office actions from the USPTO have been entered in the application. Claims of all three inventions I, II and III have been present since the application was filed. As evidenced by the prosecution history, claims of all three inventions I, II and III have already been searched. In particular, claims 1-11 of invention I have been searched, claims 12-17 of invention II have been searched, and claims 18-20 of invention III have been searched. Furthermore, as evidenced by the PTO Form 892 accompanying the May 19, 2005 Office action, the Examiner has already searched class 324, 142, where all three inventions are classified. Accordingly, it cannot be a burden for the Examiner to search the cited inventions because the Examiner has already done so and has already searched the relevant classes and subclasses. Therefore, the examiner's restriction requirement in the August 3, 2006 Office action should be withdrawn.

III. Conclusion

For the foregoing reasons, taken either independent or as a group, it is submitted that the examiner (A) has failed to provide sufficient reasons why each invention as claimed is either independent or distinct, and (B) has failed to establish that examination of all three inventions I, II and III would present a serious burden on the examiner. Accordingly, Applicant traverses the examiner's restriction requirement. Favorable reconsideration of the restriction requirement, along with allowance of the claims of this application, is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Russ Fowler", with a long horizontal flourish extending to the right.

Russell E. Fowler

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